

REMARKS

Applicants thank Examiner Amareld for allowing claims 34-38 in the present application. The pending Office Action withdrew from consideration claims 12-14, 17, and 39-44. Respectfully, the response to the previous restriction and election requirement pointed out the reasons that all of the claims should be considered, and those points remain valid and are reemphasized herein. Further, the Office Action noted an error in a previous classification of claims 39-44, yet made the restriction requirement final. Because the grounds for the restriction requirement have been changed, it should not be final, and because the subject matter of claims 39-44 in fact significantly overlaps the subject matter of claims 1-38, the restriction requirement should be reconsidered and withdrawn.

As to the election requirement, the Office Action did not rebut Applicants' previous showing that the requirement should be withdrawn. Instead, the Office Action deemed the requirement proper because the Applicants have not admitted that the alleged species are obvious variants of each other. Respectfully, even in the absence of such an admission, it has been demonstrated that the election requirement should be withdrawn, for the reasons advanced in the previous response. Further, as demonstrated below there are allowable generic claims in this case. The Office Action has not met the burden to clearly establish that a species election is necessary in this case or rebutted Applicants' arguments, and thus the election requirement should be reconsidered and withdrawn.

Turning now to the substantive rejections in the Office Action, claim 1 was initially rejected as allegedly anticipated by the Amrein reference (U.S. Patent No. 6,371,957). The Office Action contends that the embodiment of FIG. 12 or that of FIG. 14 of Amrein is the structure that allegedly anticipates claim 1, as the Office Action relies on item 77 (shown only in

those figures) as the recited “grommet member.” However, those embodiments do not show all elements of claim 1. For example, item 3 (considered a “receiver member” in the Office Action) does not have an aperture for a closure member. Item 20 of Amrein, alleged to be a “closure member,” fits in opening 11 of item 77, not in opening 25 of item 3. In other words, item 3 has an aperture, but it is not and cannot be for the alleged “closure member” 20.

Further, it is evident from Amrein that its items 77 and 3 are not rotatable with respect to each other (see, e.g., column 3, lines 26-34). FIGS. 12 and 14 of the reference are not shown in an assembled state, and therefore there is no support in the reference for a conclusion that items 77 and 3 can rotate with respect to each other. In fact, a fair consideration of the Amrein reference shows that items 77 and 3 do not rotate with respect to each other. If they did, then their openings for a rod (items 54 and 81) would be out of alignment and would not accommodate a rod. Moreover, other embodiments (e.g. FIGS. 2 and 7) show a tight connection between outer item 3 and inner item 8 (apparently analogous to item 77). Thus, the structure relied on in the Office Action does not show relative rotatability of items 3 and 77, nor do other structures in the reference.

Claim 1 was also initially rejected as allegedly anticipate by the Ramsey reference (U.S. Patent No. 4,946,122), which discloses a generic post clamp. The Office Action alleges that Ramsey’s item 38 corresponds to the recited “receiver member,” and its item 62 corresponds to the recited “grommet member.” As claim 1 recites, its grommet member must be capable of holding a part of a bone implant member, and the Ramsey reference does not establish that its item 62 can hold part of a bone implant member. Respectfully, in this case the examiner cannot merely respond by saying the proposed use is non-distinguishing, because it is clear that the device as shown in Ramsey cannot be used for bone implants. This is seen because, among other

reasons, if the Ramsey device (as seen in its FIG. 3) is used to hold a bone implant through its item 62, a “quarter turn screw” 88 to tighten item 62 will be inaccessible between item 38 and a bone. A fair and reasonable reading of the Ramsey reference shows that its item 62 cannot be used to hold a bone implant.

Further, the Office Action does not identify where in Ramsey the “passage” in the “grommet member” recited in claim 1 can arguably be found. That lack means that the burden to show that all elements of the claim are shown in the reference has not been met. The Office Action suggests that Ramsey shows an “extension collar,” and thus it appears that the Office Action means that the collar corresponds to the recited “extension” in claim 1. Ramsey describes a bore 66 in its item 62, which is clearly parallel to (i.e. not transverse to) that collar. Accordingly, the Office Action has not shown a passage and extension as recited in claim 1.

Claim 1 was further rejected as allegedly anticipated by the Taylor reference (U.S. Patent No. 6,579,292). The Taylor reference has a single inventor, Harold Taylor, who the Office Action noted is also an inventor in the present application. Because the disclosure in the Taylor reference was invented by Mr. Taylor, it follows that subject matter in the present application that overlaps subject matter in the Taylor reference comes from Mr. Taylor, and thus is not invention “by another.”

Further, as indicated above, claim 1 has been amended to identify a non-threaded connectedness between the recited grommet member and receiver member. That amendment is not necessary to overcome the Taylor reference, which reflects an inventor’s own contribution that is not statutorily barred.

To summarize, then, claim 1 is not anticipated by any of the Amrein, Ramsey or Taylor references, for at least the reasons noted above. Applicants reserve the right to show that other

aspects of claim 1 are missing from these references or that the references are otherwise inapplicable, as may be appropriate.

Claims 2-25 are allowable due to their dependence from allowable claim 1, and many are also allowable on their own merit. With respect to claim 2, for example, the Office Action claimed that “prongs” marked with threads 27 (FIG. 14) are compressible. However, item 12 of Amrein threads in between those “prongs.” Thus, the “prongs” cannot be compressible, since compression of them will not permit the threaded insertion of item 20 between them. As to claims 4 and 5, the Amrein reference does not show a block between the alleged “prongs,” nor that such a block may be a clip, a ball, a cylinder or a planar solid, and the Office Action does not argue those points. As to claim 6, the Office Action suggests that FIGS. 1 and 10 show a flange. As noted above, the Office Action relies on FIGS. 12-14 for the structure that anticipates the claims, and it is improper in an anticipation rejection to import changes from other structures. Moreover, the supposed flanges in FIGS. 1 and 10 of Amrein do not interact with a portion of the putative “receiver member” to retain an extension, as the claim recites. The supposed “flanges” on item 7 (FIG. 1) and item 75 (FIG. 10) cannot retain those items in Amrein’s item 3. Similarly, the supposed “flange” 80 of Ramsey that was argued in the Office Action does not interact with a portion of Ramsey’s item 38. Item 90 is required to retain item 80 with item 38. As to claim 7, the Office Action does not show how a shank is held within Amrein’s item 77, and in fact no part of Amrein shows a shank of a bone implant member held in a passage of its item 77.

As to claim 15, the Office Action suggests that items 80 and 81 are “countersunk edge[s].” Respectfully, items 80 and 81 cannot fairly be called “countersunk,” since they are simply flat surfaces on which a rod sits. There is no basis for calling a flat surface

“countersunk,” given the usual definition of that term. As to claim 20, the Office Action does not point out what the recited “protrusion” could be in the Ramsey reference.

Turning now to independent claim 26, that claim was initially rejected as allegedly anticipated by the Amrein reference. Several of the facts noted above are applicable to the Office Action’s analysis of claim 26 as well. For example, as discussed above Amrein does not show or suggest a receiver member with an aperture for a closure member, or a countersunk edge to an opening transverse to a channel. The Office Action’s allegation that items 80 and 81 of Amrein meet the countersunk edge language is not supported by the reference, both because they cannot be said to be “countersunk” (as discussed above) and because they abut the channel of Amrein’s item 3. Regarding FIG. 13, if item 3 is considered to have a “channel” extending substantially perpendicular to the page, and a “transverse opening” extending to the right of item 3, then item 80 is adjacent that supposed “transverse opening,” but no part of any “prongs” are inserted into that “transverse opening.” If the “transverse opening” is considered to be anywhere else, then item 80 is not in it. As to FIG. 14, if item 3 is considered to have a “channel” extending substantially perpendicular to the page, then item 81 is clearly in the channel, and not in a “transverse opening.” There simply is no way to force the Amrein reference into the language of claim 26.

Claims 27-34 are allowable due to their dependence on independent claim 26, and several are also allowable on their own merit. As to claims 27 and 28, the Office Action is confusing because it asserts that both are anticipated by Amrein, but also that Amrein does not show disks and must therefore be combined with the Taylor reference. Applicants agree that the Amrein reference does not show the disks recited in claims 27 and 28, and therefore the reference cannot anticipate them.

Claims 27-34 were initially rejected as allegedly obvious over a combination of the Amrein reference and the Taylor reference. There are several reasons for withdrawing the rejection of these claims. First, as noted above, the Taylor reference should not be used against this application as it is an inventor's own work that is not statutorily barred.

Second, there is no proper motivation to combine the references as the Office Action suggests. The Office Action states that a motivation would be "to provide a directional locking means," and that "it is also possible that the device of Amrein . . . may be modified to included the intermediate disks as described by Taylor." Taking the latter statement first, a mere possibility of a modification is not sufficient to establish either a motivation to combine or the desirability of the combination. Just because a combination may be possible, does not mean it is desirable or that a person of ordinary skill would be motivated to make the combination. As to the "directional locking means" language, there is no need to place a "directional locking means" between items 77 and 3 of Amrein. As already noted, items 77 and 3 of Amrein cannot rotate with respect to each other because that would prevent placement of a rod and prevent the Amrein device from operating. There would accordingly be no need to have a means for locking the two items in various angular positions, which is apparently what the Office Action intends with the phrase "directional locking means." Further, there is no need to introduce any such means as between any other parts of the Amrein device, since its screw is already lockable at various angles to items 77 and 3, and because no other part may be locked in various angles or directions while maintaining the operability of the Amrein device. Thus, since no proper motivation to combine has been provided, a *prima facie* case of obviousness has not been made.

Further, introducing the disks of Taylor into the Amrein device would change the fundamental operation of the Amrein device. For example, if such disks are placed between

items 3 and 77, then item 3 cannot perform its task of contacting and holding item 77, and the head of the screw within it. If the disks are placed between the nut 26 and item 3, then the nut may not be able to thread onto item 77, and also no disk would be connected to item 77. If the disks are between item 77 and the screw head, then item 77 would not contact the screw head as the Amrein device requires. It is clear that the Taylor disks cannot be placed in the Amrein device without substantially changing the way the Amrein device works.

Accordingly, for at least the above reasons no proper case of obviousness has been made with respect to claims 27-33. These claims are allowable on that basis as well as their dependence from allowable claim 26.

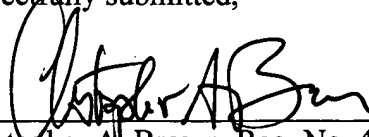
Because at least claims 1, 7-9 and 25 are allowable and generic, consideration of the claims withdrawn due to the species election is respectfully requested. Those claims are allowable because of their dependence on allowable claims, and perhaps on their own merit.

It should be understood that the above remarks are not intended to provide an exhaustive basis for patentability or concede the basis for the rejections in the Office Action but are simply provided to address the rejections made in the Office Action in the most expedient fashion. Applicant reserves the right to later contest positions taken in the Office Action that are not specifically addressed herein. Further, no limitation of the claims is intended by any of the remarks herein. The claims are intended to have the full scope to which their language entitles them, including equivalents.

In conclusion, Applicants again thank Examiner Amareld for allowing claims 34-38, and request reconsideration of the remaining claims in this case. As established above, the remaining pending claims are allowable over the cited references, and therefore a Notice of Allowance is

respectfully requested. Examiner Amareld is invited to call the undersigned attorney to discuss any further issues that may remain.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Christopher A. Brown", is written over a horizontal line.

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